Remarks

New claims 22-25 are intended to substitute for original claims 1-4. New claim 22 corresponds to a combination of original claims 1, 2, and 3 and new claim 24 corresponds to a combination of original claims 1, 2, and 4. The alternative defined by new claims 22 and 24 is very similar to the independent claim 1, for which the European Patent Office recently issued a counterpart patent in view of the same prior art the Examiner relies upon in the present application before the USPTO.

New dependent claims 23 – 24 are identical and are added to more specifically recite when the detector will be used to detect light and when it will be used to detect electrons.

New claims 26 – 31 are intended to substitute for original claim 14. Independent claims 26 and 28 correspond to the alternative of claims 1 and 2, respectively. New claims 27 and 29 correspond to claims 2 and 4, respectively. New claims 30 and 31 comprise the feature of original claim 14 that the particle beam device is an electron beam device. The broadening to a particle beam device is intentionally to also cover systems in which the primary beam is not an electron beam, but some other beam of particles, such as ion. This broadening is supported in the specification.

New claim 32 is intended to substitute original claim 15, which the Examiner already indicated would be allowable if rewritten in independent form.

In original claim 13, we delete the phrase comprising "a scintillator and" because the scintillator is already included in new claim 22. Besides this change in claim 13, all other dependent claims 5 – 12 are maintained with their actual wording other than being

PAGE 9/14 * RCVD AT 7/8/2008 2:39:12 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/9 * DNIS:2738300 * CSID:5053230865 * DURATION (mm-ss):02-54

changed to dependent on new claims 22 and 23, respectively as appropriate to original claims 1 and 2.

In claims 16 and 17, the dependency is changed to become dependent on new claim 32.

Prior Art Rejection

The Office Action states that Applicant cannot rely upon the foreign priority papers to overcome rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. **Applicant notes that a certified translation was properly submitted on 12/30/2003, and should be made of record as a result of that submission. Applicant respectfully requests that the Examiner review the record and correct the record accordingly.**

With respect to the Essers (US 6,707,041), Applicant respectfully believes that Essers is not properly prior art. First, it appears that the Examiner did not apply the correct law, because the Examiner states that the actual provision of § 102 (e) shall not apply when the reference document results from an international application filed **before** November 29, 2000. However Essers US 6,707,041 results from an international application filed **on** November 29, 2000 so that for the present case the new and actual law should apply.

However, Applicant respectfully believes that, in the present case, it is not decisive whether the old or new provision of § 102 (e) is applied, because the US filing date of Essers '041 or it's § 102 (e) date is May 29, 2002, which is eleven months after the filing date, i.e. June 29, 2001, of the PCT application from which the present

PAGE 10/14 * RCVD AT 7/8/2008 2:39:12 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/9 * DNIS:2738300 * CSID:5053230865 * DURATION (mm-ss):02-54

application results. Therefore, this reference cannot be proper prior art in relation to the present application.

WO98/22971 discloses a detector – through having a grid or mesh electrode – that is only designed to detect light generated in the gas within the sample chamber. The detector does not have a scintillator, but only a light pipe or light conductor by which light generated in the gas is conducted to a photo-multiplier (see the paragraph bridging pages 9 and 10). In contrast to a light pipe or light conductor, a scintillator is normally understood by the person skilled in the art to be a body made of a material that generates light flashes when high energy electrons impinge on it. Therefore, we cannot understand how this prior art document should anticipate the new independent claims. Also, the Examiner does not rely on any specific disclosure in this reference.

Danilatos US 4,992,662 only discloses the detection of light generated in the gas within the sample chamber. Also, this reference does not include any teaching to a system that can detect electrons as well as light. Therefore, for Danilatos, the same is true as was true for WO98/22971. Further, with respect to Danilatos '662, the Examiner does not rely on any specific disclosure.

JP 11 096956 discloses a detector that can detect electrons (by the scintillator 17), as well as light. However, this system does not include a conductive coating in the form of a grid or mesh in conjunction with the scintillator.

Furthermore, none of the references disclose a detector that can be operated with high vacuum condition in the sample chamber with a pressure below 10^{-3} hPa, as well as with gas in the sample chamber with pressure above 10^{-3} hPa. Therefore, because of this

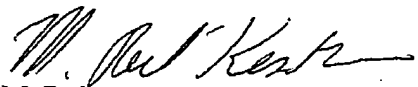
PAGE 11/14 * RCVD AT 7/8/2008 2:39:12 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/9 * DNIS:2738300 * CSID:5053230865 * DURATION (mm-ss):02-54

additional feature in new independent claims 22, 24, 26 and 28, these new independent claims cannot be anticipated by the cited references.

A three-month extension of time in which to respond to the outstanding Office Action is hereby requested. A PTO 2038 authorizing charging a credit card in the amount of $1,050 is enclosed for the prescribed Large Entity three-month extension fee. The PTO 2038 also authorizes charging the credit card for the additional claims fees (six claims in excess of 20 - $300, and five independent claims, or 2 independent claims in excess of 3 - $420, for a total of $720 in excess claims fees. Thus, the PTO 2038 authorizes charging $1,050 + $300 + $420 = $1,770 total. If any **additional fees** are due beyond $1,770, please charge deposit account 11-0665. An additional page is included for this purpose.

Applicant respectfully believes this submission places the claims in condition for allowance. Wherefore, further consideration and allowance of the claims, as amended, is respectfully requested.

Respectfully submitted,



M. Robert Kestenbaum
Reg. No. 20,430
11011 Bermuda Dunes NE Albuquerque, NM 87111
Phone (505) 323-0771 Fax (505) 323-0865

I hereby certify under 37 CFR 1.18 that this correspondence is being submitted to Mail Stop Response with Fee, Art Unit 2881, PO Box 1450, Commissioner for Patents, Alexandria, Va. 22313-1450 by facsimile transmission, fax number (571) 273-8300, on 07/08/2008.



M. Robert Kestenbaum

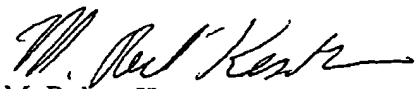
RECEIVED
CENTRAL FAX CENTER
JUL 0 8 2008

additional feature in new independent claims 22, 24, 26 and 28, these new independent claims cannot be anticipated by the cited references.

A three-month extension of time in which to respond to the outstanding Office Action is hereby requested. A PTO 2038 authorizing charging a credit card in the amount of $1,050 is enclosed for the prescribed Large Entity three-month extension fee. The PTO 2038 also authorizes charging the credit card for the additional claims fees (six claims in excess of 20 - $300, and five independent claims, or 2 independent claims in excess of 3 - $420, for a total of $720 in excess claims fees. Thus, the PTO 2038 authorizes charging $1,050 + $300 + $420 = $1,770 total. If any **additional fees** are due beyond $1,770, please charge deposit account 11-0665. An additional page is included for this purpose.

Applicant respectfully believes this submission places the claims in condition for allowance. Wherefore, further consideration and allowance of the claims, as amended, is respectfully requested.

Respectfully submitted,



M. Robert Kestenbaum
Reg. No. 20,430
11011 Bermuda Dunes NE Albuquerque, NM 87111
Phone (505) 323-0771 Fax (505) 323-0865

I hereby certify under 37 CFR 1.18 that this correspondence is being submitted to Mail Stop Response with Fee, Art Unit 2881, PO Box 1450, Commissioner for Patents, Alexandria, Va. 22313-1450 by facsimile transmission, fax number (571) 273-8300, on 07/08/2008.



M. Robert Kestenbaum

PAGE 13/14 * RCVD AT 7/8/2008 2:39:12 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/9 * DNIS:2738300 * CSID:5053230865 * DURATION (mm-ss):02-54